

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ANDREW J. FISH and MICHAEL D. KINNEY

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Appeal 2007-3697  
Application 10/015,533  
Technology Center 2100

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Decided: June 12, 2008

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Before LANCE LEONARD BARRY, JAY P. LUCAS, and CAROLYN D.  
THOMAS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

ORDER REQUIRING APPELLANTS TO BRIEF AN  
ADDITIONAL MATTER

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-20. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

## II. LAW

In an *ex parte* appeal, the Board of Patent Appeals and Interferences "is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (BPAI 2001). "[T]he Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board. These formal matters should not be combined in appeals to the Board." MPEP § 706.01 (8th ed., Rev. 5 Aug. 2006).<sup>1</sup>

Furthermore, an appeal "brief shall contain . . . a copy of the claims involved in the appeal." 37 C.F.R. § 41.37(c)(1)(viii) (2006).<sup>2</sup> It "shall not include any new or non-admitted amendment . . . ." *Id.* § 41.37(c)(2).

## III. ANALYSIS

Here, the Appellants submitted a "Response After Final . . . on June 30, 2006." (Br. 2.) They admit, "Amendments submitted in that Response were not entered . . . ." (*Id.*) In their Appeal Brief, however, "[t]he submitted amendments are attached in Section XI. UN-ENTERED AMENDMENTS" (*id.*), and the Appellants "traverse this decision and request that the claims be amended, as in section XI. UN-ENTERED

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<sup>1</sup> We cite to the version of the Manual of Patent Examiner Procedure in effect at the time of the Appeal Brief. The current version includes the same rules.

<sup>2</sup> We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

AMENDMENTS, and that the arguments be considered in light of these amendments . . . ." (*Id.* 8.)

The Board lacks authority to review the Examiner's decision to deny entry of the amendments and to direct him to enter the amendments. The Appellants' request to overturn the Examiner's denial should not be included in this appeal.

The non-admitted amendments also should not be included in the Appeal Brief. Inclusion of arguments directed to limitations contained in the non-admitted amendment is confusing, moreover, as well as improper.

Furthermore, the arguments in the "Claims 1-3, 5-8 and 17-19 are patentable over Harmer in view of EFIS" section of the Appeal Brief jump back and forth between claim 1 to claim 7. More specifically, the arguments begin by addressing "[i]ndependent claim 1" (*id.* 5) and logically proceed to "independent claim 7." (*Id.* 7.). The arguments then jump back to "claim 1." (*Id.* 8) Afterward, they jump forward to "claim 7." (*Id.*) Such back-and-forth treatment of claims is difficult to follow.

#### IV. ORDER

"We decline to substitute our speculation for the greater certainty that should come from the Appellants." *Ex Parte Dietz*, No. 2007-2386, 2008 WL 696147, at \*2 (BPAI 2008). Instead, they must file an Amended

Appeal Brief that corrects the aforementioned defects. More specifically, the Amended Appeal Brief should omit the following items:

- any request to overturn the Examiner's decision to deny entry of any amendments or to direct him to enter any amendments.
- any copy of any non-admitted amendments.
- any arguments directed to limitations contained in any non-admitted amendments.

Furthermore, the Amended Brief should address the claims *seriatim*, without jumping back-and-forth. For example, all arguments for claim 1 should be presented before those for claim 7.

No new arguments may be added to the Amended Brief. Nor may any of the arguments in the original Appeal Brief be amplified. The Amended Brief submitted must be self-contained with respect to all arguments. "No prior briefs should be referenced or incorporated therein. Furthermore, any additional Answer submitted by the Examiner should be self-contained with respect to all rejections and arguments; no prior Answer or Office action should be referenced or incorporated therein." *Dietz*, at \*2.

Under 37 C.F.R. § 41.50(d), we give the Appellants a non-extendable time period of thirty days within which to respond to this order. Failure to comply with the order within that time may result in the *sua sponte* dismissal of their appeal.

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No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDERED; 37 C.F.R. § 41.50(d)

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